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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/035,624	03/05/98	OTTESEN	H

EXAMINER	
CHEVALIER,R	
ART UNIT	**PAPER NUMBER**
2712	9

LM12/0510
INTERNATIONAL BUSINESS MACHINES CORP.
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DEPARTMENT 917, BUILDING 006-1
INTELLECTUAL PROPERTY LAW
ROCHESTER NY 55901-7829

DATE MAILED: 05/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/035,624	Ottesen et al
Examiner	**Group Art Unit**
Robert Chevalier	2712

☒ Responsive to communication(s) filed on *Mar 5, 1998*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *2-56* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *2-56* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *6*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claim Rejections - 35 USC § 112

1. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example:

(1) Claims 1-13 are indefinite because they are depended upon a rejected claim 1. Clarification is requested.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

surface and from the data storing regions to the upper and lower transducers as specified in claims 13-14, 23-25, 29, 42-42, and 52-53. (Russo et al's Figure 1, and the corresponding disclosure).

It would have been obvious to one skilled in the art to modify the Abecassis' apparatus wherein the recording/reproducing means provided thereof would incorporate the capability of controlling the transfer of the source program segments from an upper and lower transducers to the plurality of data storing regions disposed on any of a lower disk surface and an upper disk surface and from the data storing regions to the upper and lower transducers in the same conventional manner as is shown by Russo et al. The motivation being increase the recording density of the recording medium as suggested by Russo et al.

With regard to claims 3-5, 15-17, 28, 30-33, 43-45, 51, and 56, the feature of the data storage including an upper data storing region disposed on the upper disk surface and a lower data storing region disposed on the lower disk surface as specified thereof is present in the proposed combination indicated above. (See Russo et al's Figure 1, components 116, 124, 126, 132, and 134).

. With regard to claims 6, 18, 34, and 46, the feature of the forward and reverse sequential transferring of the source program segments respectively to the upper and lower data storing regions to the upper and lower transducers as specified thereof is present in the proposed combination indicated above. (See Russo et al's abstract).

With regard to claims 7, 19, 27, 35, 47, and 55, the feature of the source program being arranged in a plurality of packets as specified thereof is present in the proposed combination indicated above. (See Abecassis'Figures 3D and 3E).

With regard to claims 8-10, 20-22, 26, 36-38, 48-50, and 54, the feature of the spiral tracks as specified thereof would be present in the proposed combination indicated above. (See Abecassis'Figure 6, and see, Russo eta l's column 6, line 31, and 39-40).

4. Claims 11, and 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis and Russo et al as applied to claims 2-10, and 13-38, above, and further in view of Official Notice.

The proposed combination of Abecassis and Russo et al indicated above discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claim 11, including the feature of recording and reproducing video data on and from the recording medium as specified in claims 11, and 39.

The proposed combination fails to specifically disclose the feature of the video data being a compressed video data as specified in claims 11, and 39.

Examiner takes Official Notice in that it is notoriously well known in the video recording/reproducing art to compress the video data before recording the same on a recording medium as specified in clams 11, and 39.

It would have been obvious to one skilled in the art to modify the proposed combination's recording/reproducing apparatus wherein the recording/reproducing means provided thereof

would incorporate the capability of compressing the video data before recording the same on the recording medium in the same conventional manner as is well known in the video art. Examiner has taken Official Notice. The motivation being to further increase the recording density of the recording medium as suggested in the prior art.

Double Patenting

5. Claims 12, and 40, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,751,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is noted that the claimed language is somewhat different with the patented claimed language, however, one of ordinary skill in the art would readily recognize that they would operate in a similar fashion since the claimed invention would perform the same function as the patented claims.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is (703) -305-4780.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306 or 308-6296

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Art Unit:2712

Robert Chevalier
ROBERT CHEVALIER
PRIMARY EXAMINER

B. Chevalier

May 6, 2000